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No. 00-1765

In The

Supreme Court of the United States

PIONEER MAGNETICS, INC.,

Petitioner,

v.

MICRO LINEAR CORPORATION,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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QUESTION PRESENTED

1. Whether the Federal Circuit properly concluded in the alternative that a claim of inadvertence by a patent attorney, first raised during litigation, did not defeat application of prosecution history estoppel on the facts of this case, where the public patent prosecution history record shows that an amendment was made in response to a prior art rejection.

CORPORATE DISCLOSURE STATEMENT

No parent or publicly held company owns 10% or more of the stock of Respondent Micro Linear Corporation.

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Micro Linear	Respondent Micro Linear Corporation
Pioneer	Petitioner Pioneer Magnetics, Inc.
Unitrode	Unitrode Integrated Circuits Corporation
Pet.	Petitioner Pioneer Magnetics, Inc.'s Petition for a Writ of Certiorari
Pet. App.	Appendix to the Petition
Opp. App.	Appendix to this Brief in Opposition
'366 patent	U.S. Patent No. 4,677,366, reproduced in the "Lodging" filed separately by Petitioner on May 23, 2001
Carpenter	U.S. Patent No. 4,437,146, cited during prosecution of the '366 patent
PTO	United States Patent and Trademark Office
A___	The indicated page of the Joint Appendix before the Court of Appeals for the Federal Circuit below

BRIEF IN OPPOSITION

Respondent Micro Linear Corporation respectfully submits its Brief in Opposition to the petition for a writ of certiorari to the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the Court of Appeals (Pet. App. 1a-11a) is reported at 238 F.3d 1341. The District Court's stipulated summary judgment order of noninfringement (Pet. App. 12a-17a) is unreported. The District Court's claim construction ruling on the "switching analog multiplier circuit" claim language presently at issue (Opp. App. 1a-26a) is unreported and did not appear in the Appendix to the Petition. It is reprinted in the Appendix herein.

STATEMENT OF THE CASE

This is a patent case that involves the routine application of prosecution history estoppel – a doctrine consistently recognized and applied by this Court for over a century and by the Federal Circuit since its inception. There is no split among the Circuits, no unresolved question of federal law, and no conflict with decisions of this Court. Rather, this case concerns the unremarkable notion that prosecution history estoppel applies when "the amendment was made [during patent prosecution] to avoid prior art, the classic basis for the application of prosecution history estoppel." Pet. App. 9a. Thus, the

disposition of this case is *not* affected by this Court's recent grant of certiorari in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, Docket No. 00-1543. The application of classic prosecution history estoppel is unrelated to the questions presented in *Festo*, and therefore, cannot be affected by its outcome. *See infra* section IV.

The present case involves the '366 patent, assigned to Petitioner Pioneer. It is undisputed that each and every claim of the '366 patent requires a switching analog multiplier circuit. Pet. App. 13a. It is also undisputed that Micro Linear's accused product has no switching analog multiplier circuit. *Id.* at 14a; Opp. App. 28a. Therefore, the non-switching multiplier in Micro Linear's product could not literally infringe the '366 patent, and the parties so stipulated. Pet. App. 15a ("Plaintiff shall not have the right to appeal the unopposed determination that the accused products do not literally infringe the 'switching analog multiplier circuit' element."). Only the doctrine of equivalents remained.

The District Court issued a 29-page opinion construing the claims of the '366 patent, including the "switching analog multiplier circuit" language.[1] Opp. App. 1a-26a. Based on the court's interpretation of that phrase, Pioneer stipulated to summary judgment of noninfringement. Pet. App. 13a-17a. The issue on appeal to the Federal Circuit was whether prosecution history estoppel precluded Pioneer's assertion that the non-switching multiplier of

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[1] Pioneer elected not to reproduce this November 12, 1998 claim construction order. It is reproduced herein as an appendix. Instead, Pioneer reproduced a July 19, 1999 claim construction order that interpreted claim language not at issue in the Petition. Pet. App. 20a-38a.

Micro Linear's product could be equivalent to the "switching analog multiplier circuit" called for by the '366 patent. After a careful review of the patent, specification, and public prosecution history record, the Federal Circuit concluded that prosecution history estoppel was properly applied. Pet. App. 9a.

An exchange during oral argument before the Federal Circuit, between the Court and counsel for Pioneer, succinctly summarizes the facts of this case:

> JUDGE: But you ended up with a claim 1 which recites a switching multiplier circuit, right?
>
> MR. BROWN: Absolutely.
>
> JUDGE: And what you're trying to do is squirm away from the word "switching" because the accused device is non-switching, is that right?
>
> MR. BROWN: That's correct.
>
> JUDGE: How can you avoid – even if that word switching had been there originally, you'd probably be out of court. But you put it in. You put it in, and there was prior art. Carpenter, right?
>
> MR. BROWN: There was what?
>
> JUDGE: Prior art. Carpenter. Isn't that the prior art?
>
> MR. BROWN: Carpenter.
>
> JUDGE: Carpenter, yes, sorry. I left Boston only 45 years ago. And that was a non-switching amplifier [*sic*, multiplier], right?
>
> MR. BROWN: You're saying – oh, yes.

JUDGE: Yes. And so the word "switching" distinguishes over Carpenter?

MR. BROWN: Yes.

Opp. App. 28a. These facts do not raise any unique or controverted legal issues. On the contrary, "it is perfectly well settled in this court by frequent decisions that where an inventor, seeking a broad claim which is rejected, in which rejection he acquiesces, substitutes therefor a narrower claim, he cannot be heard to insist that the construction of the claim allowed shall cover that which has been previously rejected." *Computing Scale Co. of Am. v. Automatic Scale Co.*, 204 U.S. 609, 617 (1907); *see also Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U.S. 425, 429 (1894). Thus, the Federal Circuit properly applied prosecution history estoppel because Pioneer's "amendment was made for a reason related to patentability, to avoid prior art." Pet. App. 11a.

I. The Prosecution History of the '366 Patent

On May 12, 1986, Pioneer filed its application for a patent, which included nine claims. Pet. App. 2a. Claim 1 was the only independent claim. *Id.* at 2a-3a. All nine claims of the application were rejected by the examiner on September 24, 1986. Pet. App. 45a. The patent examiner concluded that claim 1 was "clearly anticipated by Carpenter." *Id.*

In response to the examiner's rejection, Pioneer amended claim 1, stating to the PTO that: "It is believed clear that there is no showing in the cited Carpenter Patent 4,437,146 of the *specific combination* set forth in amended claim 1." Pet. App. 49a-50a (emphasis added).

This representation to the Patent Office was equally applied to claims 7-9: "Amended claims 7 and claims 8 and 9 are all dependent on amended claim 1, and are likewise believed to be allowable." *Id.* at 50a. Claims 2-6 were canceled. *Id.* at 48a.

The "specific combination" overcoming Carpenter was the incorporation of the "switching" limitation and the additional limitations of the original application claims 2-6. Therefore, the addition of this limitation was squarely in response to the pending anticipation rejection under Carpenter. Carpenter teaches the use of a multiplier in a power supply, but lacks a *switching* analog multiplier. Pet. App. 9a; A1746 ¶ 27(a); A1753 ¶ 50(h); Opp. App. 28a.

After Pioneer submitted these amendments to the Patent Office, the examiner allowed application claims 1 and 7-9 without any further substantive actions. The '366 patent issued on June 30, 1987.

II. The Background of the Litigation

Despite the finding by the Federal Circuit that Pioneer's addition of the "switching" limitation was in response to a prior art rejection, and therefore results in classic prosecution history estoppel, Pioneer persists in arguing that its amendment was "inadvertent."

Over a decade passed since the '366 patent issued, and Pioneer did nothing about the allegedly "inadvertent" error by its patent attorney. Pioneer did not seek to

have the patent reissued without the "switching" limitation during the statutory two-year window following issuance, as it was entitled to do under 35 U.S.C. § 251.

Despite its inaction, Pioneer was fully aware of the presence of the "switching" limitation in its patent. In late 1991, Pioneer's then-exclusive licensee, Unitrode, accused Micro Linear of infringing the '366 patent. A1515. Pioneer encouraged Unitrode's patent enforcement strategy and secretly conferred with Unitrode about these allegations of patent infringement. A818. Six years before Pioneer concluded that the "switching" limitation was supposedly "inadvertent," Micro Linear explained to Pioneer's exclusive licensee as follows: "To elaborate, claim 1 of the '366, at column 6 line 25, specifically calls for 'a *switching* analog multiplier' (emphasis added). However, the multiplier in our ML4821 device is not a switching-type multiplier." A1516. In response, on December 18, 1992, Unitrode informed Micro Linear that it did not intend to further pursue the issue of patent infringement.[2] A1523. On December 14, 1995, several years after Unitrode dropped its charge of patent infringement against Micro Linear, Pioneer brought this suit. A143.

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[2] An independent opinion rendered by Unitrode's own attorneys also concluded that products that used a non-switching multiplier, such as Unitrode's, could not infringe the claims of the '366 patent. A480-91. In 1994, Pioneer was informed of this opinion, specifically, that a product using "a nonswitching analog multiplier" would fall "outside the scope of the claims of the '366 patent." A1461 ¶ 9.

It was not until claim construction proceedings in the District Court that Pioneer revealed its litigation-induced interpretation of "switching analog multiplier circuit": that the word "switching" should "not be given limiting effect in this claim." A1048. In support of this position, Pioneer procured a declaration (in 1998) from the attorney who prosecuted the patent, professing to have added (in 1986) the word "switching" inadvertently. A1077.

In the District Court's decision construing the "switching analog multiplier circuit" element, Judge Lourdes Baird stated that she could not "take the drastic measure of ignoring the clear, plain language of Claim One, and thereby corrupt '366's public record." Opp. App. 15a. She determined that prosecution history estoppel was applicable to the patent claims, due to the applicant's amendment to avoid the pending prior art rejection. *Id.* at 18a.

The Federal Circuit conducted a *de novo* review of the record and affirmed the District Court's determination that the amendment was made to overcome a prior art rejection.

> We therefore conclude that Pioneer has failed to meet its burden of establishing a reason unrelated to patentability for its amendment. Our own examination of the prosecution history convinces us that the amendment was made to avoid prior art, the classic basis for the application of prosecution history estoppel.

Pet. App. 9a; *see also id.* at 10a ("the addition of this limitation was made to avoid prior art") & 11a ("the addition of the 'switching' limitation is responsive to the examiner's anticipation rejection and assisted Pioneer in

distinguishing its invention over prior art"). Micro Linear incorporates by reference the statement of facts in the opinion below. *See id.* at 2a-5a.

In its Questions Presented, Pioneer does not challenge the Federal Circuit's determination that the amendment "was made for a reason related to patentability, to avoid prior art." *Id.* at 11a. Rather, Pioneer ignores this inconvenient fact and instead boldly presumes that the amendment was made "without any nexus to a statutory requirement for patentability." Pet. at ii. Only as a result of this studied ignorance of the facts below does Pioneer proceed to debate the extraneous question of whether or not an allegedly inadvertent amendment may give rise to prosecution history estoppel.

THE WRIT SHOULD BE DENIED

I. The Federal Circuit Correctly Applied Classic Prosecution History Estoppel Under Well-Established Principles

Prosecution history estoppel was applied in the case because the patentee had amended its claims in response to a prior art rejection by the examiner under 35 U.S.C. § 102(b). Pet. App. 9a. That doctrine has been recognized by this Court for over a century, *Morgan Envelope*, 152 U.S. at 429, and has been applied on a regular basis by the Federal Circuit within its area of special expertise. Accordingly, this case does not present an important federal question, much less one that is unsettled or in conflict with relevant decisions of this Court. Sup. Ct. R. 10(c). To the contrary, an analysis of the prosecution

history of the '366 patent shows that the instant case involves the correct application of a properly stated rule of law.

A. The Federal Circuit Properly Applied this Court's Precedents Holding that Amendments to Overcome the Prior Art Result in Prosecution History Estoppel

Prosecution history estoppel is properly applied in this case because Pioneer added the "switching" limitation in response to a prior art rejection by the patent examiner. Pet. App. 9a; *Computing Scale*, 204 U.S. at 617. But if that were not enough, an analysis of the prosecution history of the '366 patent further demonstrates that prosecution history estoppel was applied consistent with the precedents of this Court.

First, statements made by Pioneer in the public prosecution history record plainly demonstrate that Pioneer's amendment was to overcome prior art. As explained by the Federal Circuit, "the prosecution history shows that Pioneer recognized that the combination of elements was important to the allowance of the claims." Pet. App. 10a. In response to the patent examiner's prior art rejection, Pioneer represented to the PTO that the amended claim recited the invention "in precise details,"[3] *id.* at 49a, and that the "specific combination" overcame the rejection in view of Carpenter. *Id.* at 49a-50a. Pioneer's reliance on its

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[3] In the Petition, Pioneer substitutes an ellipsis for this portion of the prosecution history, upon which the Federal Circuit relied. *Compare* Pet. at 4 *with* Pet. App. 10a-11a & 49a.

"specific combination" to overcome the prior art served as a disclaimer of power supplies with non-switching multiplier circuits. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1942) ("By the amendment he recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference.").

Second, the amendment made by Pioneer to insert the "switching" limitation did, in fact, allow Pioneer to overcome the Carpenter prior art. This was clear from the record, A1746 ¶ 27(a); A1753 ¶ 50(h), and was admitted by Pioneer in open court before the Federal Circuit. Opp. App. 28a. Accordingly, Pioneer is bound by its amendment. *Hubbell v. United States*, 179 U.S. 77, 83 (1900) ("If an applicant, in order to get his patent, accepts one with a narrower claim than that contained in his original application, he is bound by it."). Limitations added during prosecution are strictly construed against the patentee. *Exhibit Supply*, 315 U.S. at 137.

Third, if Pioneer truly amended the claim for reasons other than the pending prior art rejection, it was required to ensure that the public prosecution history so indicated. Pioneer failed to do so. All that the public could discern from the public record was Pioneer's agreement to disclaim power supplies with non-switching multiplier circuits. Pioneer "cannot expect the courts to wade through the history of the art, and spell out what they might have claimed, but have not claimed." *Keystone Bridge Co. v Phoenix Iron Co.*, 95 U.S. 274, 277 (1877).

Fourth, even if there were any doubt that the amendment was made to overcome prior art, Pioneer failed to

overcome the presumptive application of prosecution history estoppel. Well before issues of claim construction arose in the present case, this Court held in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.* that the burden is squarely with the patentee to establish the reason for an amendment during prosecution. 520 U.S. 17, 33 (1997). Thus, Pioneer was on notice that it was required to affirmatively demonstrate reasons unrelated to patentability for adding the "switching" limitation. As demonstrated herein, *see also infra* section I.B, and as the Federal Circuit concluded, Pet. App. 7a, Pioneer failed to adequately meet its burden.

Pioneer argues that amended claim 1 was similar to proposed claim 6, and that proposed claim 6 was rejected only for patentability reasons other than prior art. Pet. at 4. Pioneer should not be permitted to rely on speculative negative implication from the PTO's rejection of claim 6.[4] The District Court squarely considered the argument but dismissed it as a "display of acrobatic deductive reasoning." Opp. App. 14a. The Federal Circuit similarly concluded that the record did not support Pioneer's argument. Pet. App. 7a. Pioneer's petition to this Court is

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[4] The examiner never indicated that claim 6 was allowable at all, as he would have been required to do if it were otherwise allowable but for its dependence on an independent claim. Manual Pat. Examining Proc. § 707.07(j). If anything, Pioneer forestalled any further prior art rejections by electing to cancel claim 6, Pet. App. at 48a, and instead using limitations borrowed from a number of claims (including claim 6) to overcome the prior art rejection of claim 1. *Id.* at 11a ("switching" limitation "assisted Pioneer in distinguishing its invention over prior art").

merely an invitation for this Court to re-examine the same record for a third time.[5]

The question of whether Pioneer's "claim 6 argument" is sufficient to overcome the *Warner-Jenkinson* presumption is the type of "case-by-case determination" that this Court has entrusted to the Federal Circuit's special expertise. *Warner-Jenkinson*, 520 U.S. at 40. Since *Warner-Jenkinson*, the Federal Circuit has repeatedly determined whether amendments were made for reasons related to patentability, and has ferreted out cases (such as the present one) where the patentee attempts to disguise a classic case of prosecution history estoppel as something else. *See, e.g., Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1326-27 (Fed. Cir. 1999); *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 829-30 (Fed. Cir. 1999); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1432-33 (Fed. Cir. 1997). Certiorari is not warranted to micromanage this exercise. *Cf.* Sup. Ct. R. 10.

B. The Federal Circuit Did Not Reversibly Err in Determining that the Alleged Evidence of Inadvertence Did Not Prevent the Application of Prosecution History Estoppel

Against the weight of the public prosecution history record, Pioneer offers a cursory, one-sentence passage from a declaration by its patent attorney, Mr. Beecher, who (years after the '366 patent issued) claimed to have

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[5] The reasons why the 35 U.S.C. § 112 rejection of claim 6 does not permit Pioneer to avoid prosecution history estoppel is sufficiently set forth in the record below. *See* Pet. App. 10a-11a; Opp. App. 14a-16a.

made a "mistake" in adding the word "switching." A1077. The Federal Circuit sagely discounted the weight of this newly-minted evidence. Use of Mr. Beecher's privately-held recollections would not "apprise the public of what is still open to them," as a patent is required to do. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996). While courts may be called upon to "evaluate the testimony [of experts] in relation to the overall structure of the patent," *id.* at 389, "judges are not, however, obliged to blindly follow such testimony," *id.* at 387 (quoting A. Walker, Patent Laws § 189, at 173 (3d ed. 1895)). This is particularly true where, as here, the testimony plainly is litigation-induced and not contemporaneous with the time of patenting. *See, e.g., Senmed, Inc. v. Richard-Allan Med. Indus., Inc.*, 888 F.2d 815, 819 n.8 (Fed. Cir. 1989).

It was not error for the Federal Circuit to reject Pioneer's self-serving claim of inadvertence. Twelve years had passed between the amendment of the claims in 1986 and Mr. Beecher's 1998 declaration. *See* Pet. App. 50a; A1077; A1079. Yet, Mr. Beecher offered no explanation for how he remembers having accidentally added the term "switching" over a decade ago, after having prosecuted hundreds of other patents. A178. The Federal Circuit was well-justified to discount the declaration. *Miller v. Brass Co.*, 104 U.S. 350, 352 (1881) ("The pretence in this case that there was an inadvertence and oversight which had escaped the notice of the patentee for fifteen years is too bald for human credence.").

There is simply no reason for this Court to repeat the exercise that the Federal Circuit and District Court have already completed and to delve into prosecution history

to determine whether or not Pioneer could rebut the *Warner-Jenkinson* presumption. There is no indication that the courts below reached an erroneous conclusion, nor is there any basis to suggest that the courts improperly applied the law.

II. This Court Should Not Review Obiter Dicta Statements of the Federal Circuit Concerning Inadvertent Amendments

Pioneer frames both of its Questions Presented around dicta in the Federal Circuit's opinion suggesting that alleged "inadvertence" does not by itself overcome the application of prosecution history estoppel. Because this dicta has no precedential effect, and because it did not depart from this Court's holdings on the subject, certiorari should not be granted.

A. Review is Not Warranted Because the Questions Presented are Directed to an Alternative Ruling Not Essential to Determination of the Case Below

The Federal Circuit affirmed the application of prosecution history estoppel because "the amendment was made to avoid prior art." Pet. App. 9a. Consequently, the Federal Circuit's discussion of the *effect of* inadvertent amendments was merely dicta, because no inadvertence was found.

In its Petition, Pioneer expressly calls out a portion of the Federal Circuit's decision that states: "*Even if we were*

to accept Pioneer's explanation for its amendment, inadvertence is not a sufficient reason to overcome the bar of prosecution history estoppel on the facts of this case." Pet. at 9 (quoting Pet. App. 8a) (emphasis added). Pioneer focuses on the Federal Circuit's discussion of the effect of "inadvertent" amendments, but that discussion was completely unnecessary to the outcome of the case below. The Federal Circuit explicitly held that the "switching" amendment was *not* inadvertent, but deliberate: it was made to avoid a prior art objection. Pioneer's two Questions Presented are framed around the unstated assumption that the Federal Circuit was wrong, and that the amendment was "inadvertent." Both Questions Presented, in other words, are not even reached unless this Court first reverses the Federal Circuit's *de novo* affirmation of the District Court's examination of the prosecution history.

As dicta, the Federal Circuit's comments about the effect of inadvertent amendment do not carry the force of precedent. *In re McGrew*, 120 F.3d 1236, 1238 (Fed. Cir. 1997) ("[D]ictum is not authoritative. It is the part of an opinion that a later court, even if it is an inferior court, is free to reject.") (quoting *United States v. Crawley*, 837 F.2d 291, 292 (7th Cir. 1988)). Consequently, even if the Federal Circuit's discussion of inadvertent amendments was wrong as a matter of law, there is no need to reverse the decision below. Certiorari is inappropriate because the obiter dicta statements of the Federal Circuit "present[ ] nothing reviewable by this Court."[6] *Stickel v. United*

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[6] Even if this dicta were an actual holding, it would still have no precedential effect on cases that do not present the

States, 76 S. Ct. 1067, 1068 (1956) (Harlan, J.); *see also ETSI Pipeline Project v. Missouri*, 484 U.S. 495, 516 n.11 (1988); *Smith v. Butler*, 366 U.S. 161, 161 (1961) (writ dismissed where decisions below "did not turn on the issue on the basis of which certiorari was granted").

In contrast to Pioneer's strident critique of the Federal Circuit's dicta concerning inadvertence, Pioneer discusses the actual holding itself (that the amendment was to avoid prior art) only briefly in its Petition, and substantially misrepresents what occurred below. In footnote 1, Pioneer asserts that the Federal Circuit's holding that the amendment was made to avoid prior art was in error because "not even the trial court reached such a conclusion." Pet. at 5 n.1.

That statement is demonstrably false. In an opinion Pioneer failed to include in its appendix, the District Court expressly found that Pioneer was "estopped by the file wrapper doctrine" because "the Patent Office accepted the amendments of Original Claims One through Five as distinguished from prior art based on these substantive changes, which included the switching limitation." Opp. App. 18a; *see also id.* at 8a, 13a-14a & 17a. The Federal Circuit has already affirmed this conclusion of the District Court based on a *de novo* examination of the prosecution history. Pet. App. 5a. For this Court to even reach the dicta contested by Pioneer, it must conduct

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unique facts of the instant case (*see supra* section I.B). The Federal Circuit stated only that "inadvertence is not a sufficient reason to overcome the bar of prosecution history estoppel *on the facts of this case*." Pet. App. 8a (emphasis added).

a second *de novo* review of the same evidence. Nothing suggests that such an effort is worthy of certiorari.

B. A Claim of Inadvertence Does Not Effect a Wholesale Exemption from the Doctrine of Prosecution History Estoppel

Even if properly presented as a question for this Court, the Federal Circuit's obiter dicta that "inadvertence is not a sufficient reason to overcome the bar of prosecution history estoppel on the facts of this case" is unworthy of review because it is consistent with this Court's precedents.

This Court has long recognized the fundamental importance of the public notice function of patents. "The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights." *Merrill v. Yeomans*, 94 U.S. 568, 573 (1876); *see also White v. Dunbar*, 119 U.S. 47, 52 (1886) ("The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."); *Markman*, 517 U.S. at 390. Because patentees have the ability to amend their claims during prosecution and appeal any adverse conclusions of the patent examiner, it falls upon the patentee to clearly claim the invention. *Hubbell*, 179 U.S. at 83-84.

If a mere allegation of inadvertence were sufficient to carve out an exception to the doctrine of prosecution history estoppel, the public notice function of patents

would be rendered a nullity. The Federal Circuit was justified in discounting the claim of inadvertence "on the facts of this case," Pet. App. 8a, because Mr. Beecher's personally-held recollections provided no notice to the public that Pioneer would seek to disclaim the "switching" limitation. Mistakes by patent attorneys are a matter between the attorney and client, and Pioneer should not be permitted to exploit the alleged error of its attorney to the prejudice of the public. *Cf. Link v. Wabash R.R. Co.*, 370 U.S. 626, 633-34 (1962) ("Petitioner voluntarily chose this attorney as his representative in the action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent."). Thus, the doctrine of equivalents should not be available to eliminate an allegedly inadvertent claim limitation from a patent, as this Court has recognized. *Warner-Jenkinson*, 520 U.S. at 29 ("It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.").

III. The Effect of "Inadvertent" Amendment of Patent Claims Lacks Sufficient Importance to Warrant Review

Pioneer's assertions that the Federal Circuit's opinion "will negatively impact the patent system" are without merit. Pet. at 13. The only effect (if any) of this case on patentees is to reiterate that patents should be prosecuted carefully.

A. "Inadvertent" Amendments That May Result in Prosecution History Estoppel are Infrequent and of Negligible Importance to the Patent System

Pioneer fails to demonstrate that alleged "inadvertence" by patent attorneys raises any type of important federal question. It is notable that in discussing how the decision below will supposedly "negatively impact the patent system," Pet. at 13-15, Pioneer not once indicates the frequency or impact of "inadvertent" claim amendments. This Court long ago recognized that inadvertent amendments are rare. *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 575 (1863) ("Since the date of [the Patent Act of 1836], not only the Patent Office but the bar can furnish gentlemen fully competent to the task of drawing up proper specifications, and but little liable to commit blunders from inadvertency. Specifications now seldom issue from the Patent Office to which such an imputation can be made."). Certiorari is not warranted to address sporadic issues of no general importance. *Rice v. Sioux City Memorial Park Cemetery*, 349 U.S. 70, 74 (1955).

Even if Pioneer were somehow able to establish that inadvertent claim amendments occurred with any frequency, the Federal Circuit's dicta statements could have no negative impact on the patent system. By definition, no applicant plans to make an "inadvertent" amendment, and consequently there can be no effect on the investment and inventive efforts that the patent system is designed to promote.

B. Reissue Proceedings Already Afford Adequate Remedy for "Inadvertent" Amendment by Patentees

Congress has created a statutory mechanism (the reissue application) to allow patentees to correct "inadvertent" errors. 35 U.S.C. § 251. Under predecessor provisions to that statute, this Court has held that "[i]f the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a re-issue." *Keystone Bridge*, 95 U.S. at 278. This procedure provides adequate notice to the public and allows the PTO to offer its administrative expertise as to whether the changed claim is supported by the specification and is permissible over the prior art.

Given the availability of the reissue process, the Federal Circuit's treatment of inadvertent amendments does not pose an issue of public importance warranting this Court's intervention. The dicta below only affects careless patentees who fail to take advantage of the reissue process. Pioneer's desire for an exemption from the reissue provisions ignores the remedy already afforded by Congress and undermines the statutory protections (*i.e.*, intervening rights) that the reissue statute affords to the public.

IV. This Court's Recent Grant of Certiorari in *Festo* is Immaterial to Pioneer's Petition

In an effort to recast its claims as worthy of consideration, Pioneer strains to tie its fortunes to the petition for

certiorari in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, Docket No. 00-1543, *cert. granted*, 533 U.S. ___, 69 U.S.L.W. 3673 (June 18, 2001). *See, e.g.*, Pet. at 9, 13 & 15 ("[f]ollowing the footsteps of *Festo*"; "its desire to expand *Festo*"; "the unfortunate legacy of *Festo*"). This effort is entirely misplaced. There was no dispute in *Festo* as to whether prosecution history estoppel applied to amendments made in response to prior art rejections, because according to petitioner in that case, "[t]he claims were never rejected in view of prior art." *See* Pet. for Writ of Cert., No. 00-1543, at 3. However, here Pioneer's patent *was* amended in response to a prior art rejection, in that the relevant claims were found fully anticipated by Carpenter.

An examination of issues in *Festo* demonstrates that the questions presented by Pioneer have nothing to do with those presented in *Festo*. The first question in *Festo* is whether claim-narrowing amendments including those "*not* related to prior art" create prosecution history estoppel. *Id.* at i (emphasis added). Here, by contrast, the Federal Circuit found that Pioneer's amendment "*was* made to avoid prior art." Pet. App. 9a (emphasis added).

The second question in *Festo* is "[w]hether the finding of prosecution history estoppel completely bars the application of the doctrine of equivalents" for the claim element. *See* Pet. for Writ of Cert., No. 00-1543, at i. This issue is nowhere mentioned in Pioneer's Petition, and therefore, the second question of *Festo* is not properly raised in this case. *See* Sup. Ct. R. 14.1(a). This is not surprising. A patent element directed to a "switching" analog multiplier circuit cannot possibly encompass by

equivalents the "precise converse," namely, Micro Linear's non-switching multiplier circuit, as the District Court noted. Opp. App. 18a.

In *Festo*, the most vociferous dissenter was Judge Pauline Newman. In briefing the petition for certiorari, petitioner and numerous amicus curiae in *Festo* extensively relied upon Judge Newman's lengthy dissent. However, the disputed issues in *Festo* are entirely unrelated to the application of prosecution history estoppel to Pioneer's amendment over the prior art. Thus, Judge Newman joined the unanimous opinion in *this* case, concluding that the instant case presents a "classic" case of prosecution history estoppel. The application of prosecution history estoppel in patent cases such as this one is well-established and, therefore, unworthy of certiorari. *See Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 221 (1940) ("The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer."). Thus, even if this Court were ultimately to reverse *Festo*, it would not affect this case. Any reversal of *Festo* would not affect the basic conclusion of the Federal Circuit that this case presents a classic instance of estoppel based on prior art. Vacating this case for reconsideration after any possible reversal of *Festo*, as Pioneer seems to suggest, would not change its outcome.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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June 25, 2001

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

PIONEER MAGNETICS, INC., a California corporation, Plaintiff, v. MICRO LINEAR CORPORATION, a Delware corporation, Defendant. AND RELATED COUNTERCLAIMS.	Case No. CV 95-8307 LGB (Ex) INTERPRETATION OF U.S. PATENT 4,677,366 (FILED NOV 12 1998)

I. INTRODUCTION.

This litigation arises out of the alleged infringement of a power supply circuitry patent, identified as United States Patent 4,677,366 (" '366"). Currently before the court is plaintiff's *Markman* motion requesting interpretation of the patent. The Court INTERPRETS Claim One's "switching analog multiplier circuit" as follows: (1) the plain language of the patent and its prosecution history require that Claim One contain the limiting effect of the modifier "switching;" (2) therefore, the doctrine of file wrapper estoppel precludes the finding that a "non-switching multiplier" is equivalent to a "switching multiplier"; and (3) the phrase does not constitute means-plus function language. The Court also INTERPRETS Claim One's "circuit means" to constitute means-plus-function language. Finally, the Court ORDERS the parties to file

additional briefing on the interpretation of all other terms in dispute, if any, in compliance with the procedures detailed below.

II. FACTUAL AND PROCEDURAL BACKGROUND.

A. Description of the Patented Invention.

The patent in question describes a power supply circuitry designed to supply a steady electrical current source to another circuit. (Blauschild Decl., 3:19-20). Specifically, the power supply receives variant and inconsistent levels of input voltage and then emits a constant output voltage. (Wilkinson Decl., 27:25-28:2). This steadying output is described as the "unity power factor." (Blauschild, 3:22-26; Wilkinson, 34:12-15).

B. Procedural History.

On December 14, 1995, plaintiff Pioneer Magnetics filed a complaint against Micro Linear for patent infringement. The complaint asks for relief from the alleged infringement of United States Patent '366 by defendant's use, sale, and manufacture of "unity power factor" power supplies. This Court exercised subject matter jurisdiction pursuant to 28 U.S.C. § 1338.

On February 14, 1996, defendant answered the complaint, asserting several affirmative defenses, and counterclaimed for declaratory relief. Plaintiff answered the counterclaim with several affirmative defenses on March 7, 1996.

On October 30, 1996, defendant amended its answer to the plaintiff's complaint.

Between October 1996 and May 1998, the parties filed several motions for summary judgment involving the asserted affirmative defenses. Denying all motions but one, the Court granted defendant's motion for summary adjudication as to all claims by plaintiff based on infringing activities that occurred before December 14, 1989.

On January 12, 1998, defendant filed a motion for leave to amend its answer and for an award of fees and costs. On February 23, 1998, the Court granted leave but not the award. The amended answer, deemed filed on February 23, 1998, asserted additional affirmative defenses.

Significant to the parties' current disagreement over which terms are in dispute, on January 29, 1998, by telephone conference, the Court set procedures for the *Markman* hearing, laying out the following:

1) On or before February 16, 1998, each side was to file and serve an identification of each patent claim phrase on which that side sought Court interpretation, together with the exact interpretation that that side contended was correct.

2) On or before March 2, 1998, each side was to file and serve a statement agreeing to or disputing each interpretation urged by the opposing side while reciting the exact interpretation of each disputed term that it contended was correct.

3) On or before March 23, 1998, plaintiff was to file and serve its memorandum of points and authorities and evidence in support of its interpretations of the disputed claim phrases.

4) On or before April 13, 1998, defendant was to file and serve its memorandum of points and authorities and evidence in support of its interpretation of the disputed claim phrases.

5) On or before May 4, 1998, plaintiff was to file and serve its memorandum of points and authorities and evidence in reply. An April 14, 1998 stipulation altered these dates.

On February 17, 1998, the parties filed a list of claims in dispute. Plaintiff requested the interpretation of two phrases, and defendant requested the interpretation of twenty-three phrases. On February 18, 1998, plaintiff filed an *ex parte* application to strike defendant's requests for claim construction determinations, asserting that the majority of defendant's terms did not constitute either a "case or controversy" for this Court to adjudicate under Article III, Section II of the United States Constitution. In support of this argument, plaintiff pointed to defendant's responses to interrogatories that explained the basis for defendant's claim of non-infringement. Plaintiff argued that because defendant identified only two claim terms at issue in the responses, only two terms were open to interpretation. Defendant opposed the application on February 20, 1998, arguing that it was not under any obligation to supplement these responses given the Court's stay on discovery. Plaintiff filed a reply on February 23, 1998. On February 25, 1998, the Court denied plaintiff's *ex parte* application. The parties filed statements reciting the interpretation of each disputed term that it contended was correct.

Also pertinent to the parties' disagreement over which terms are in dispute, after granting plaintiff a page extension on its *Markman* motion, on May 4, 1998, defendant filed an application to extend the page limit on its opposition by ten pages; plaintiff opposed this application, arguing that defendant would use the space to brief claims not in controversy. On May 7, 1998, the Court granted the defendant's application.

On April 6, 1998, plaintiff filed its motion for interpretation of patent claim '366. After advocating that the Court should only interpret two claims on three different occasions – once during the January 29, 1998 telephone conference, once in its *ex parte* application to strike defendant's request to interpret claims, and once in its *ex parte* application to limit the pages of defendant's opposition – plaintiff argues for a fourth time in the body of the *Markman* motion that the claims presented by defendant, other than those two also presented by plaintiff, should not be interpreted. (Motion, 19:11-20:2). Instead of presenting its interpretation of these claims in the body of the motion, plaintiff asks the Court to consider the arguments of declarant Bruce L. Wilkinson, pages forty through forty five, effectively increasing the length of its motion by six pages.

On April 3, 1998 the parties filed an amended submission of claims in dispute, shortening the list of terms in contention to thirteen.

On May 4, 1998, defendant filed its opposition to plaintiff's interpretation, and on May 26, 1998 plaintiff filed its reply.

On September 15, 1998 defendant filed an *ex parte* application for the setting of a telephone conference. In plaintiff's September 16, 1998 opposition, it noted that the parties were "willing to agree on more of the patent claim definitions proposed by plaintiff." (September 16, 1998 *Ex Parte Opposition*, 2:n.1). However, the parties never updated the Court on whether they had agreed on more terms.

C. Language of the Patent.

United States Patent '366 describes four claims, one of which is independent and three of which are dependent. The terms that are interpreted in this order are underlined.

1. In a switch power supply: a rectifier adapted to be connected to the alternating current line; a boost converter connected to the output of said rectifier, said converter including an input circuit having a series-connected inductance coil and an output circuit having a shunt-connected storage capacitor, and further including a power switch connected between the inductance coil and the storage capacitor; and a control circuit connected to said power switch for providing a switching control signal for said converter having a current reference which tracks the waveform of the alternating current line voltage to cause the power supply to exhibit unity power factor to the alternating current line, said control circuit including a voltage error amplifier connected to the output of said converter and to a source of reference voltage for producing an output which is a function of the difference between the output voltage of the converter and the reference voltage from the source, a *switching analog multiplier circuit* connected to the output of said voltage

error amplifier and to the output of said rectifier to produce an output which is proportional to the output of said voltage error amplifier multiplied by the instantaneous line voltage and divided by the RMS line voltage squared, a current regulator amplifier connected to the converter and to the multiplier and responsive to a voltage representing the current flow in the converter and to the output of the multiplier for producing a current error signal, and *circuit means* including a pulse-width modulator connected to said current regulator amplifier and responsive to said current error signal therefrom for introducing said switching control signal to said power switch.

2. The combination defined in claim 1, in which said multiplier is a switching type, and in which said control circuit includes a timer and ramp signal generator for supplying clock signals to said switching multiplier and ramp signals to said pulse width modulator.

3. The combination defined in claim 1, in which said power switch comprises a field effect transistor.

4. The combination defined in claim 1, in which said rectifier comprises a full-wave diode rectifier.

'366 Patent, column 6, lns. 7-47 (emphasis added).

D. Prosecution History of Patent '366.

The parties do not dispute the following facts concerning the prosecution history of patent '366.

On May 12, 1986, Keith Beecher ("Beecher"), Pioneer's patent attorney, filed the original patent application that the Patent and Trademark Office eventually issued as the '366 Patent. (Elson Decl., Exh. 1, 3:22; Elson Decl., Exh. 2, 11). As part of the application, Beecher

submitted nine patent claims for examination ("Original Claims"). (Beecher Decl., 21:8-9; Elson Decl., Exh. 2). Original Claim One was the sole independent claim, with the other eight claims directly or indirectly dependant on Original Claim One. (Beecher Decl. 21: 10-13; Elson Decl., Exh. 2). Three of these Original Claims affect the construction of '366. First, Original Claim Four states,

> The combination defined in claim 3, in which said control circuit *includes a multiplier* connected to the output of said voltage error amplifier and to the output of said rectifier to produce an output which is proportional to the output of said voltage error amplifier multiplied by the instantaneous line voltage and divided by the RMS line voltage squared.

(Elson Decl., Exh. 2, 12 (emphasis added)). Second, Original Claim Six states, "[t]he combination defined in claim 5, in which said last-named circuit means includes a pulse width modulator." (Elson Decl., Exh. 2, 12). Third, Original Claim Seven states,

> The combination defined in claim 6, in which said *multiplier is a switching type*, and in which said control circuit includes a timer and ramp signal generator for supplying clock signals to said switching multiplier and ramp signals to said pulse width modulator.

(Elson Decl., Exh. 2, 12 (emphasis added)).

On September 24, 1986, the Patent and Trademark Office rejected all nine claims. (Elson Decl., Exh. 5, 16). The office rejected Original Claims One through Five and Eight and Nine as anticipated by prior art. (Elson Decl., Exh. 5, 18). It also rejected Original Claims Six and Seven "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The phrase 'said last-named circuit means' lacks proper antecedent basis in the claims." (Beecher Decl., 21:23-25; Elson Decl., Exh. 5, 17). Beecher did not dispute with the patent examiner the rejection of the claims. (Beecher Decl., 22:8-9).

On November 3, 1986, the applicants filed an Amendment with the Patent and Trademark office. (Elson Decl., Exh. 7). The Amendment made the following changes to the claims in controversy:

- The term "converter" in Original Claim One was amended to be specified as a "boost converter" in Claim One. Original Claim Two, which specified "said converter" as a "boost converter," was eliminated. (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 11).

- The tense of "tracking" in Original Claim One was changed to "which tracks" in Claim One. (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 11).

- The language in Original Claim Three was added to Claim One, with the elimination of the introductory phrase "[t]he combination defined in claim 1" and a change of tense of "includes" to "including." (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 11).

- The language of Original Claim Four was added to Claim One, with the elimination of the introductory language "[t]he combination defined in claim 3, in which said control circuit includes." In addition, the term "multiplier" in Original Claim Four was designated a "switching analog multiplier circuit" in Claim One. (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 12).

- The language of Original Claim Five was added to Claim One, with the elimination of the introductory

language "[t]he combination defined in claim 4, and which includes." In addition, the comma after "current error signal" was changed to a semi-colon. Also, "circuit means connected" in Original Claim Five was changed in Claim One to "circuit means including a pulse-width modulator connected." Original Claim Six, which designated the "last-named circuit" to include a "pulse width modulator," was eliminated. (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 12).

- Original Claim Seven was renumbered Claim Two. In addition, "[t]he combination defined in claim 6" was changed to "[t]he combination defined in claim 1." (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 12).

Beecher made the following relevant comments in the Remarks section of the patent amendment. "Claims 2-6 have been cancelled [sic], and the subject matter of those claims has been incorporated into amended claim 1." (Motion, Exh. 4, 85). He further remarked, "[c]laim 7 has been amended so that it may depend on amended claim 1, and also in order that the multiplier recited in claim 7 may be specified as a 'pulse-width' type." (Motion, Exh. 4, 85).

Beecher declares that he had no intention of adding the word "switching" to Claim One. (Beecher Decl. 23:12-13).

On February 2, 1987, the patent examiner issued a notice of allowability for the amendment. (Elson Decl., Exh. 9). On June 30, 1987, '366 issued to applicants. (Elson Decl., Exh. 1, 3:75).

III. INTERPRETATION OF PATENT '366.

A. Legal Standard for Patent Interpretation.

In *Markman v. Westview Instruments, Inc.*, the Supreme Court held that the interpretation of a patent claim – the portion of the patent document that defines the scope of the patentee's rights – is a matter of law exclusively within the province of the court and is not a factual question for the jury. 517 U.S. 370, 372 (1996). The *Markman* decision suggested that a trial court could consider various types of evidence when interpreting a patent, including expert testimony. *See* 517 U.S. at 388-90. Shortly after the Supreme Court handed down *Markman*, the Federal Circuit, in *Vitronics Corp. v. Conceptronic, Inc.*, expanded on the Court's dicta concerning evidence available to a trial court in interpreting patent claims. 90 F.3d 1576, 1581-83 (Fed. Cir. 1996). The Federal Circuit held that if intrinsic evidence can, by itself, resolve ambiguity in a patent term, then a court may not rely on extrinsic evidence, such as expert testimony, to construe the term. *See id.* at 1583. A trial court may only use extrinsic evidence when intrinsic evidence fails to illuminate the meaning of the disputed claim. *See id.* Moreover, extrinsic evidence cannot broaden the reach of a claim or contradict explicit language. *See id.*

The Federal Circuit detailed a hierarchy of specific types evidence that a court may consider. When interpreting a patent, a trial court must first look at the language of the claim itself. *See id.* at 1582. Courts should typically construe terms by their common, customary meaning, but a patentee is allowed to define her own terms in the specification section of the patent. *See id.* Therefore,

courts must always review the specification, which frequently acts as an explicit or at least implicit "dictionary" for claim terms. *See id.* The language in the specification is dispositive, and "it is the single best guide to the meaning of a disputed term." *Id.* In addition, a court may consider the prosecution history of the patent as evidence of term meaning. *See id.* This history contains the complete record of all the filings and examinations before the Patent and Trademark Office, including representations made by the applicant regarding the significance of claims. *See id.* The history also limits the interpretation of terms by recording the exclusion of any term definition disclaimed during the prosecution. *See id.*

Only when intrinsic evidence fails to resolve ambiguity in a disputed claim term may a court rely on extrinsic evidence. *See id.* at 1583. The policy rationale supporting this evidentiary limitation is that prospective patentees must have access to public records concerning the patent to "design around" a prior art. *Id.* If expert testimony or other extrinsic evidence were permitted to alter the record, then this public benefit would be frustrated. *See id.* Accordingly, a court can only examine extrinsic evidence if the evidence does not contradict the claim language, the specification, or the prosecution history but instead supplements it. *See id.* at 1584-85.

B. Disputed Terms.

1. "Switching Analog Multiplier Circuit."

a. As a Threshold Issue, the Plain Language of Claim One and Its Prosecution History Require that "Switching" Modify the Word "Multiplier."

The parties' *Markman* papers focus primarily on the disputed term "switching analog multiplier circuit" in Claim One. Plaintiff argues that the claim mistakenly contains the word "switching," and therefore, it should not be given limiting effect in this claim. (Plaintiff's Second Amended Statement of Patent Claim Interpretations ("Plaintiff's Interpretations"), Exh. B, 6). Meanwhile, defendant argues that the claim cannot be interpreted to include a non-switching analog multiplier because the claim is explicitly limited by the word "switching." (Defendant's Identification of Patent Claim Terms ("Defendant's Interpretations"), Exh. A, 6).

Specifically, plaintiff argues that the Court should effectively ignore the "switching" modification in Claim One based on three rationales: (1) inclusion of the term is logically inconsistent with the prosecution history; (2) Beecher declares that he erroneously inserted the "switching" term into Claim One; and (3) case law does not permit a redundant "switching" limitation in Claim One and its dependant Claim Two.

First, plaintiff argues that inclusion of the word "switching" was "obvious error," and therefore, it should not limit Claim One. (Motion, 9:15-22). Plaintiff argues that because the Patent and Trademark Office rejected Original Claims Six and Seven on the basis of improper form, rather than invalidation by prior art, Original

Claims Six and Seven impliedly contained subject matter acceptable to the Patent Office. (Motion, 9:15-22; Beecher Decl., 21:17-25). Therefore, according to plaintiff's argument, Original Claim Six, which does not reference a switching analog multiplier circuit in the body of the claim, would have been acceptable to the Patent Office but for its procedural deficiency. (Beecher Decl., 22:1-5). This, in turn, allegedly signifies that any claim would have been acceptable to the patent office without a switching limitation, thereby implying that the switching limitation in Original Claims One through Six was not critical to distinguishment from prior art. (Beecher Decl., 22:1-5, 22:14-17).

In an attempt to buttress this display of acrobatic deductive reasoning, plaintiff cites to the Remarks section of the amended application. In that section, Beecher remarked that the subject matter of Original Claims One through Six was incorporated into Claim One. (Motion, Exh. 4, 85). In addition, he noted that "amended claim 1 represents original claim 6 in independent form, and that claim 6 has been amended to overcome the objection. . . . " (Motion, Exh. 4, 85). Furthermore, while the Remarks section recognizes various changes in the amendment, it fails to recognize the modification of "multiplier" to "switching analog multiplier" in Claim One. (Motion, Exh. 4, 85-86).

While plaintiff provides a possible explanation for inconsistencies between the original and amended applications, it by no means dispels all questions concerning the prosecution history. For example, plaintiff argues that the inclusion of "switching" in Claim One is "obvious error" because the word "switching" is also present in

Claim Two; however, plaintiff fails to explain why the inclusion of "switching" in Claim Two is not the error, with Claim One containing the proper limitation. Moreover, while Original Claims Six and Seven contained technical deficiencies, the record fails to indicate definitively that Original Claim Six would have been acceptable solely upon correction of the noted deficiencies. Alternatively, plaintiff could have added language to the Original Claims regardless of the office's technical deficiency finding. Finally, plaintiff makes no attempt to explain why it never attempted to correct the "obvious error" in the 1987 patent before this instant suit.

The Court cannot take the drastic measure of ignoring the clear, plain language of Claim One, and thereby corrupt '366's public record. As articulated by the Federal Circuit in *Vitronics Corp. v. Conceptronics, Inc.*, a patent's public record serves a "notice function" to the world concerning the proprietary nature of the patented invention; the public can review and rely on the record, apply established rules of claim construction, ascertain the scope of the patentee's invention, and "design around" the claimed invention. 90 F.3d 1576, 1583 (Fed. Cir. 1996) (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978-79 (Fed. Cir. 1995)). To take an about face and ignore the explicit "switching" limitation would radically alter '366's public record, thereby preventing prospective patentees from differentiating their inventions from '366. *See* 90 F.3d at 1583.

Second, courts interpreting patent claims cannot contradict claim language with extrinsic evidence. *See Vitronics Corp.*, 90 F.3d at 1581-83. When the language of the patent plainly defines the scope of the patent, as in this

case, a court cannot examine expert testimony. *See id.* Interpreting "switching" multipliers to include "non-switching" multipliers based on Beecher's declaration would run afoul of this mandate. *See id.* Accordingly, this Court cannot afford any weight to Bleecher's declaration that he made an error in including the word "switching."

Finally, plaintiff argues that "an independent claim should not be interpreted in a manner which causes a claim dependent upon it not to be differentiated." (Reply, 14:3-15:2). Therefore, plaintiff argues, if the "switching analog multiplier circuit" limits Claim One, it would not be differentiated from Claim Two which also includes a "switching" limitation. (Reply, 14:3-15:2). However, claim differentiation only requires the incorporation of some additional limitation not present in an independent claim. *See* 37 C.F.R. § 1.75(c) (1997) ("One or more claims may be presented in dependent form, referring back to *and further limiting* another claim or claims in the same application.") (emphasis added). Although Claim Two reiterates Claim One's "switching" limitation, it nonetheless is differentiated from Claim One with the inclusion of a "timer and ramp signal generator." Therefore, plaintiff's argument that Claims One and Two are redundant lacks merit based on a plain reading of the two claims.

b. The Doctrine of File Wrapper Estoppel Prevents a Finding that a "Non-switching Multiplier" Is Equivalent to a Switching Multiplier."

Under the doctrine of equivalents, a patent owner may hold as an infringement a product or process that does not correspond to the literal terms of the patent

claims but performs substantially the same function in substantially the same way to obtain the same result. *See Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S.Ct. 1040, 1045 (1997). However, the doctrine of file wrapper estoppel maintains that if the patent applicant narrowed her claims by amendment or cancellation to meet the objections of the Patent and Trademark Office examiner as to the patentability of the original claims in light of the prior art, she and her assigns cannot later "recapture" by construction the full scope of the claims that she previously surrendered. *See id.* at 1049-50.

In the instant interpretation, the parties request that the Court identify what equivalents of "switching multiplier," if any, are barred by the doctrine of file wrapper estoppel. (Motion, 10:1-12:5; Opposition, 10:17-12:4). Plaintiff argues that because inclusion of the word "switching" was in error and not required of Claim One, the doctrine of file wrapper estoppel does not bar interpreting a "non-switching" multiplier as equivalent to the multiplier in Claim One. (Motion, 10:19-26). Meanwhile, defendant argues that the prosecution history prevents the finding that a non-switching multiplier is equivalent to a switching multiplier. (Opposition, 11:22-12:4).

The prosecution history clearly sets forth what claims plaintiff surrendered in its Amendment of '366. The Patent Office rejected Original Claims One through Five as anticipated by prior art. (Elson Decl., Exh. 5, 16). Beecher did not dispute the rejections of these claims on this ground. (Beecher Decl., 22:8-9). Nor is there a record of appeal of the rejection. *See I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429 (1926) ("If dissatisfied with the rejection

he should pursue his remedy by appeal. . . . Whether the examiner was right or wrong in rejecting the original claim, the court is not to inquire.").

Aside from changes in syntax, verb tense, and style, the amended patent application contained three substantive changes over Original Claims One through Five. First, the term "converter" in Original Claim One was amended to be specified as a "booster converter" in Claim One. (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 11). Second, the term "multiplier" in Original Claim Four was designated a "switching analog multiplier circuit" in Claim One. (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 12). Third, "current means connected" in Original Claim Five was changed in Claim One to "circuit means including a pulse-width modulator connected." (*Compare* Elson Decl., Exh. 1, 10 *with* Elson Decl., Exh. 2, 12). Therefore, the Patent Office accepted the amendments of Original Claims One through Five as distinguished from prior art based on these substantive changes, which included the switching limitation. Accordingly, a power supply that uses a "non-switching" multiplier, the precise converse of a "switching" multiplier, must fall outside of the permissible range of equivalents, as estopped by the file wrapper doctrine.

c. The "Switching Analog Multiplier Circuit" Does Not Constitute Means-Plus-Function Language.

Patent claims must "particularly point[ ] out and distinctly claim[ ] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112. Traditionally, a claim will comply with this statutory requirement by

describing in detail the structure that constitutes the invention. Alternatively, however, claims may describe their subject matter by the use of "means-plus-function" language. Specifically, under Section 112, "[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof." 35 U.S.C. § 112. In short, the "means-plus-function limitation contemplated by [Section 112] recites a function to be performed rather than definite structure or materials for performing that function." *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indust., Inc.*, 145 F.3d 1303, 1307 (Fed. Cir. 1998).

However, means-plus-function language only covers "the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112. Section 112, therefore, " 'rules out the possibility that any and every means which performs the function specified in the claim *literally* satisfies that limitation.' " *Id.* at 1309 (quoting *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987) (emphasis in original)). Rather, the proper test is whether the "differences between the structure in the accused device and any disclosed in the specification are insubstantial." *Id.* (citing *Valmont Indus., Inc v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993)).

Currently, the parties dispute whether the "switching analog multiplier circuit" constitutes means-plus-function language. (Motion, 12:7-14:10; Opposition, 14:16-18:9). If the term does constitute means-plus-function language, then the Court must construe it only to cover the structure disclosed in the specification or its

equivalents. If the language is not, then it is not limited to the contents of the specification.

Traditionally, claim drafters use the preface "means for" or "step for" to signal means-plus-function language. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996).

> [T]he use of the term "means" has come to be so closely associated with "means-plus-function" claiming that it is fair to say that the use of the term "means" (particularly as used in the phrase "means for") generally invokes section 112(6) and that the use of a different formulation generally does not.

Id. at 1584. At the same time, use of the word "means" is not talismanic: Its invocation does not absolutely require means-plus-function treatment, while its absence does not absolutely preclude it. *See Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996). In addition to the identification of "means" language, a trial court must "decide on an element-by-element basis, based upon the patent and its prosecution history, whether § 112 [means-plus-function language] applies." *Id.* at 531. "To invoke this statute, the alleged means-plus-function claim element must not recite a definite structure which performs the described function." *Id.* However, the recitation of some structure does not preclude application of the statute. *See Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1536 (Fed. Cir. 1991).

Applying this test to the "switching analog multiplier circuit," the Court finds that the phrase does not embody means-plus-function language. As a threshold issue, the word "means" does not modify the phrase "switching

analog multiplier circuit." More significantly, a "switching analog multiplier circuit" is itself a structure. The parties do not dispute that the word "circuit" embodies an electrical system. (Motion, 38:10-11). The circuit is also physically connected to a voltage error amplifier and a rectifier circuit, further implying structure. (Elson Decl., Exh. 1, 10:25-27). In addition, when the name of a recited term has a "reasonably understood" and concrete meaning in the art, this recognition can serve as "important" evidence of a structure. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed Cir. 1996). The defendant itself admits that "[s]withcing [sic] analog multiplier circuits were known in the power supply art at the time the patent application . . . was filed." (Blauschild Decl. 7:4-5). This suggests that the term represents a concrete entity known in the art, rather than mere short-hand language for a function particular to this patent. All these factors together support the finding that the phrase does not constitute means-plus-function language.

2. "Circuit Means."

Next, the parties dispute whether the language "circuit means" constitutes means-plus-function language. (Elson Decl., Exh. 1, 10:35-36; Motion, 17:1-18:13; Opposition, 20:11-21:14). The phrase contains the word "means," suggesting that it invokes such language. At the same time, the phrase contains language involving structure. First, the word "circuit," although a vague term, recites a physical structure. Neither of the parties dispute that a circuit is a generic term for an electronic system. (Motion, 38:10-11). However, defendant objects that because the term is generic and vague, and "[t]here would be nearly

infinite ways to implement such a means," the phrase must constitute means-plus-function language. (Opposition, 21:5). The Federal Circuit reviewed a similar argument in *Greenberg v. Ethicon Endo-Surgery. Inc.* 91 F.3d 1580, 1583 (Fed. Cir. 1996). In that case, the Circuit held that the term 'detent,' though generic, could constitute structure: "It is true that the term 'detent' does not call to mind a single well-defined structure, but the same could be said of other commonplace structural terms such as 'clamp' or 'container.' " Therefore, even if the word "circuit" does not invoke a single, well-defined mechanism, it can still constitute structure. In addition, the circuit means "includ[es] a pulse-width modulator connected to said current amplifier and responsive to said current error signal therefrom." (Elson Decl., Exh. 1, 10:35-36). In other words, the circuit means is physically connected to the current amplifier, thereby suggesting structure. Finally, the pulse width modulator, to which the "circuit means" is connected, is a recognized structure in the art, which neither party disputes. (Opposition, 20:27-21:8; Reply, 18:22-23).

When evidence of "means-plus-function" language conflicts with the use of the word "means" and the concurrent recitation of structure, such as in the present case, courts must determine whether the disputed term on the aggregate describes solely the constitution of a recited structure or the performance of a function. *See Laitram Corp v. Rexcord, Inc.*, 939 F.2d 1533, 1536 (Fed. Cir. 1991). If the latter, then the term constitutes mean [sic]-plus-function language. *See id.* In the present case, even though the claim does recite some structure, it describes a function. The circuit means must be "*responsive* to said current

error signal therefrom for *introducing* said switching control signal to said power switch." (Elson Decl., Exh. 1, 10:35-39). This responsiveness and introductory function requires the finding that "circuit means" constitutes means-plus-function language. Stated in other terms, the claim does not merely recite structure but discloses how the circuit is to effect the "signal to said power switch," thereby constituting a means for performing a function. (Elson Decl., Exh. 1, 10:35-39). Accordingly, "circuit means" must cover "the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112.

However, plaintiff argues that even if "circuit means" is interpreted to constitute "means-plus-function" language, Figure Four of the '366 serves as an alternative embodiment of "circuit means." (Reply, 20:3-6). Plaintiff provides no admissible evidence in support of this contention.[1] Therefore, the Court cannot find that Figure Four is an equivalent of "circuit means."

C. Remaining Disputed Terms.

As detailed in the "Procedural History" section of this opinion, the Court on three different occasions rejected plaintiff's arguments that the Court could only interpret two terms of '366. In its motion, plaintiff for a fourth time raises argument that defendant improperly

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[1] Plaintiff cites to Paragraph 59 of the Wilkinson declaration to evidence that one skilled in the art would view Figure Four as an equivalent of "circuit means." (Motion, 18:6-13; Reply, 20:3-6). The Court sustains defendant's objection to Paragraph 59 as lacking foundation.

identifies terms not in controversy for interpretation. (Motion, 19:9-20:2). Instead of briefing these remaining terms, plaintiff refers the Court to paragraphs sixty-three through ninety-seven of Bruce L. Wilkinson's declaration. Not only does this tactic provide plaintiff more space in its motion to brief the few terms it identifies as being in dispute,[2] but this reference also provides the Court with little support in interpreting these terms. Mr. Wilkinson is an engineer, and therefore, his declaration is devoid completely of legal argument. Defendant, which briefed all the terms, was left to anticipate plaintiff's arguments, and accordingly, a complete round of legal briefing was never effected.

The Court reminds plaintiff that trial courts are to interpret patent claims before infringement proceedings.

> The meaning of claim terms is the central issue of patent litigation. With most aspects of trial hanging on this determination – now "strictly a question of law for the court" – a conscientious court will generally endeavor to make this ruling before trial.

Loral Fairchild Corp. v. Victor Co. Of Japan, Ltd., 911 F.Supp. 76, 79 (E.D.N.Y. 1996) (quoting *Markman v. Westview Instruments, Inc.*, 53 F.3d 967, 977 (Fed. Cir. 1995)). The Court and the parties cannot determine with any precision before actual interpretation which terms and term meanings will affect the outcome of the infringement proceedings. Moreover, plaintiff agreed that both sides would submit to the Court terms that they believed were

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[2] The length of the patent interpretation papers in this case was a highly contentious issue, as outlined in the "Procedural History" section of this order.

in dispute. Plaintiff has not demonstrated any bad faith on the part of defendant in identifying the number of terms that it did, and without more, plaintiff must abide by the procedures that the Court ordered.

The disagreement between the parties over which terms are in dispute manifested itself in other areas of the interpretation briefing. For example, the Second Amended Statement of Patent Claim Terms fails to identify the "inverse-square function" terminology as in dispute but instead indicates that the parties have agreed upon the term. (Plaintiff's Interpretations, Exh. A, 4, Exh. B, 6; Defendant's Interpretations, Exh. A, 6). Yet, plaintiff devotes five pages of its motion arguing whether the function need only be substantially performed and under what conditions. (Motion, 2-6). Defendant does not directly address either of these arguments.

Especially in light of plaintiff's indication that it is in agreement with defendant on additional terms, the Court hereby ORDERS the parties to file a joint Third Amended Statement of Patent Claim Interpretations one week from the date of this order. This statement shall identify those terms still in dispute, if any, and plaintiff's and defendant's interpretations. Three weeks from the identification of terms still in dispute, the Court ORDERS plaintiff to submit supplemental *Markman* papers concerning those terms. The Court ORDERS Defendant to file its opposition to plaintiff's supplemental interpretations three weeks from plaintiff's filing. Plaintiff may file a reply two weeks from the filing of defendant's opposition. These papers shall stand on their own without reference to the original *Markman* briefings. This second set of

Markman papers shall clearly identify the terms in dispute in their headings. The papers shall not discuss infringement issues, which are *not* currently before the Court. After receipt of the *Markman* papers, the Court shall SCHEDULE a hearing date for the interpretation of remaining terms.

IV. CONCLUSION.

The Court hereby INTERPRETS Claim One's "switching analog multiplier circuit as follows: (1) the plain language of the patent and its prosecution history require that Claim One contains the limiting effect of the modifier "switching"; (2) therefore, the doctrine of file wrapper estoppel precludes the finding that a "non-switching" multiplier is equivalent to a "switching multiplier"; and (3) the phrase does not constitute means-plus-function language. The Court hereby INTERPRETS Claim One's "circuit means" to constitute means-plus-function language. The Court ORDERS the parties to file additional briefing on the interpretation of all other terms in dispute, if any, in compliance with the procedures detailed above.

IT IS SO ORDERED.

DATED: 11/10/98

/s/ Lourdes G. Baird
LOURDES G. BAIRD
United States District Judge

Unofficial Transcript of Oral Argument Before the Federal Circuit (October 5, 2000)[1]

JUDGE: Now, we've had a flurry of papers arguing about the demonstrative evidence you want to use today.

MR. BROWN: Yes, Your Honor.

JUDGE: How many matters were there? Just the one? We are going to grant the motion objecting to that item and it will not be used.

MR. BROWN: May I instead, Your Honor, mark on a blank sheet of paper some of the points I make today?

JUDGE: May you what?

MR. BROWN: May I instead mark on a blank sheet of paper, the reverse side of that, some of the points I make today to the Court?

JUDGE: Why don't we just have oral argument?

MR. BROWN: Very well. Thank you. One of the principal questions the Court has to address on this appeal is whether it should impose a file wrapper estoppel against an inconsequential difference in order to permit an inconsequential difference to avoid infringement. And in answering that question I'd like to review some of the

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[1] The Federal Circuit maintains audio recordings of oral argument. *See* Fed. Cir. R. 34 (practice note). This written transcript was generated by counsel for Micro Linear for the convenience of the Court.

key points in the prosecution history. The record shows at the time of the first office action that there were six claims among others that were pending. Claim 1 of course was independent, and claims 2 through 6 were dependent upon claim 1, either directly or indirectly.

JUDGE: But you ended up with a claim 1 which recites a switching multiplier circuit, right?

MR. BROWN: Absolutely.

JUDGE: And what you're trying to do is squirm away from the word "switching," because the accused device is non-switching, is that right?

MR. BROWN: That's correct.

JUDGE: How can you avoid – even if that word "switching" had been there originally, you'd probably be out of court. But you put it in. You put it in, and there was prior art. Carpenter, right?

MR. BROWN: There was what?

JUDGE: Prior art. Carpenter. Isn't that the prior art?

MR. BROWN: Carpenter.

JUDGE: Carpenter, yes, sorry. I left Boston only 45 years ago. And that was a non-switching amplifier [*sic*, multiplier], right?

MR. BROWN: You're saying – oh, yes.

JUDGE: Yes. And so the word "switching" distinguishes over Carpenter.

MR. BROWN: Yes.

JUDGE: It's pretty clear, isn't it?

MR. BROWN: You do have your facts right, Your Honor. But the answer is not clear, and that is not the correct answer. And the reason is the record shows that claim 6 – the record shows, of course, that the examiner rejected claims 1 through 5 based on prior art. You know that. The record also shows that the examiner did not reject claim 6 based on prior art. And the record shows that the only difference between claim 6, the non-rejected claim, and the other claims, for instance claim 5, was that claim 6 added a modulator, and modulator was also missing from Carpenter. In other words, what the record shows is that the Patent Office was ready to issue a claim without "switching."

JUDGE: But you wanted to make sure, or whoever was prosecuting the patent, wanted to make sure the patent was valid, claim 1 was valid, and so you put in all the limitations that would distinguish over Carpenter, including "switching."

MR. BROWN: No. You could say that, but the record doesn't show that. What the objective view of the record is, and of course of it's the competitor's view of the record, what he would reasonably observe in the record, is he's going to see in accordance with traditional Patent Office practice, in accordance with the C.F.R. and the M.P.E.P., that an examiner is supposed to assert all objections that he has as soon as possible. So he's going to see that the Patent Office was ready to issue claim 6 if two things were done. One, the very minor problem in the form of its language was corrected. And two, it was rewritten in independent format. And in fact, when you

look at the record, that's exactly what happened. That's exactly – that was the deal between the patent applicant and the Patent Office. The Patent Office said claim 6 has a form problem, we're not going to allow it because of that. The applicant responded in his remarks, says okay, I'm going to acquiesce to everything you're saying here. The deal I'll make with you is that I'll do what you're saying. I'll fix the problem in form and I'll rewrite claim 6 in independent form. That was what the applicant said in the remarks.

JUDGE: But he didn't rewrite claim 6, did he?

MR. BROWN: Not entirely. You're right, Your Honor.

JUDGE: He incorporated its limitations into 1.

MR. BROWN: But the deal that any reasonable person reading that file will see was made was the rewriting and the correction of the form error. And when you see that deal and that is what distinguishes this case from *Warner-Jenkinson*, from all of the other cases. None of the other cases involved a situation where the record clearly showed with illumination what it was the applicant would need to do to overcome the problem.

JUDGE: Well, we're certainly reasonable persons.

MR. BROWN: I know you are, Your Honor. That's why I'm here.

JUDGE: Isn't the thing to do then, to correct the applicant's mistake in putting "switching" in claim 1 through reissue or reexamination or something rather than leaving it there for the public to read and be, in your view, misled by, until someone gets sued for infringement?

MR. BROWN: That certainly is an option, Your Honor, that of course is only available for up to two years. And it's an option that exists in every case in which the doctrine of equivalents is asserted. So this case is not –

JUDGE: So this is worse than equivalents. You're saying "switching" is there by mistake, not that switching and non-switching are equivalent. You can't say they're equivalent because of the prior art.

MR. BROWN: No, you can say that they're equivalent. They are equivalent. They're factually equivalent. It's not just a switching, it's a switching analog multiplier. The accused product has a multiplier. It is analog. It just happens not to be switching. So the factual issue of whether there can be equivalency was actually not determined by the trial court below and I can certainly make a proffer that we're fully prepared to prove equivalency. So the opportunity to correct a unduly narrow provision of a claim through a reissue has never been held to be a bar to the resort to the doctrine of equivalents. And it should not be so held in this case.

JUDGE: It's a dilemma isn't it – I appreciate the reason why we're here is this dilemma, to take a clear limitation which in the course of prosecution is inserted, someone reading it could just as well conclude it was inserted because of a reference that was cited or not cited, but in any case because of a reference. And then to say as you tell us it was a mistake. Not that they're equivalent, but that it was a mistake to put that in the claim.

MR. BROWN: Well, I say both, to be clear. It was a mistake, and it is shown by the record. It's shown by the fact that what was going on was an operation of merging

six claims together into one, rather complex process. So the possibility of something happening is understandable. The record shows that there was also a dependent claim number 7. 7 was dependent on 1, both before and after the amendment. And 7 affirmatively recited in even a clearer fashion "switching" as a new element. So someone looking at the file, it just isn't listening to me saying this, I'm just not making this up for the first time today to address an issue. You can see it from the file. You can see from the file that a mistake was made. You can see from the remarks that what the applicant was intending to do is what he told the Patent Office, incorporate the limitations of the dependent claims 2 through 6 into 1. To write 6 in independent form. He didn't say he was adding an additional limitation. And the mistake is further shown by the fact of the rejection provided by the Patent Office. Claim 6 was not rejected on art. There was no requirement for any substantive amendment to claim 6. There was only a requirement that a matter of form be corrected. The *Warner-Jenkinson* presumption that even gives rise to the issues which we're talking about today has a predicate of a required amendment. They said four times in the case the presumption follows, and as you know, when an amendment's required, there was no substantive amendment required of claim 6 at all. We know from Judge Stone in the *Earl Supply* [*sic*] case as far back as 1942. We know that file wrapper doesn't apply to original limitations. And we know that each limitation put in the claim from the start is put there to avoid prior art. So that's not the issue. The issue was this a required amendment. It was not. The issue is whether if you nevertheless believe there's a presumption, this record overcomes it,

and it does. The record shows that the Patent Office, the deal was made before "switching" was added. The deal was you correct the form in the claim, you rewrite it in independent format, and it's very apparent that "switching" is not part of that deal. And this is what distinguishes this case from *Warner-Jenkinson*, from all of the other cases.

JUDGE: "Switching" originally in claim 6 had originally incorporated claim 4 by reference, and when you amended it, claim 6 added the multiplier.

MR. BROWN: Words are a little confusing. You had a modulator.

JUDGE: Wouldn't it logically suggest that you were trying to be emphatic? You made a mistake, but you embellished on what you had had before, be more specific, and more emphatic.

MR. BROWN: Well, let's see. The element that claim 6 had that distinguished it from the others was a modulator. What was added was "switching" which they're just completely different components of the system. And I'll reserve the rest of my time. Thank you.

JUDGE: Ms. Elson.

MS. ELSON: Good morning, Your Honors. Vera Elson on behalf of Micro Linear Corporation. Mr. Brown starts out with claiming there's some sort of deal with the Patent Office, but perhaps if we turn right to the portion of the remarks, the applicant's remarks to the Patent Office, I believe this is the crux of the dispute at A125 in the Appendix. What the applicants actually said to the Patent Office after incorporating and consolidating all of

the limitations of claims 1 through 6 and adding the "switching" limitation to what became claim 1 after making those amendments. What the applicants said, specifically, in the middle of the remarks section is "the amended claim 1 recites in precise details the various elements and components of the overall combination of the invention which results in the switched power supply having the desired characteristics representing the intendments and purpose of the present invention. It is believed clear that there is no showing in the cited Carpenter patent of the specific combination set forth in amended claim 1." In other words, as an expedient to get these claims allowed, the applicant retreated to the more "precise details" of its disclosed invention and basically made the choice, made the conscious choice, not to submit a claim without the "switching" limitation.

JUDGE: But it doesn't say that. It didn't mention "switching" in the remarks to the examiner accompanying the amendment of the rewriting of claim 1. It didn't mention "switching," he says that was a mistake, we didn't have to put that in claim 1, we've got that in the subordinate claims and we didn't intend to put it in claim 1 and anybody reading it would know that that was a mistake.

MS. ELSON: Yes, Your Honor, and we respectfully would disagree that that was a mistake or that anyone reading it would presume it to be a mistake, in fact –

JUDGE: Mistake or not it doesn't matter. It's there.

MS. ELSON: That's right. A reasonable competitor was entitled to rely on that prosecution history, see that the switching limitation was added, and interestingly on

the record, not just in the abstract, we have two reasonable competitors who looked at this prosecution history and both concluded, both Micro Linear in their opinion letter to Unitrode, and Unitrode in its opinion letter to Micro Linear which I can –

JUDGE: You're not saying we should interpret claims based on opinion letters of counsel.

Ms. ELSON: No, Your Honor, but it just happens that in this case two reasonable competitors, in reality, looked at these claims and concluded, both from outside counsel, that the switching limitation was the operative limitation, and that prosecution history estoppel would apply to anything that was non-switching.

JUDGE: That would be perhaps valid in interpreting the claim based on what its ordinary reading and writing is, but he also says there's no estoppel against an equivalency between switching and non-switching and again the portion of the prosecution history that you read to us does not flag "switching" as providing any distinction on which patentability is based. It just says I've put everything together, it doesn't mention "switching" particularly. So why would that produce an estoppel towards equivalency.

Ms. ELSON: Because, Your Honor, the Carpenter reference did include a multiplier so the obvious inference to anyone reading this file history is that the switching limitation was intentionally added to overcome the Carpenter reference.

JUDGE: But how do we know. There are a lot of other changes that were made in that claim as well which

would, taken together distinguish, did distinguish, the Patent Office said, from the prior art so why should we assume that this particular word was inserted for any particular purpose sufficient to provide an estoppel as to that specific limitation.

Ms. ELSON: There were other, the only two limitations that have been raised in the papers are the switching limitation and the pulse width modulator. In the declaration of Blauschild which was included in the appendix, Mr. Blauschild discloses that there were several other of the cited references that included a pulse width modulator, moreover some non-cited references also included a pulse width modulator. That would be at A1751 "for the patent cited on the face of the '366 patent disclosed the use of a pulse width modulator," and in the chart which is at A1766, someone reading this file history, it would be very dubious that the pulse width modulator alone would have gained allowance, that it was the "switching" element that was really the crux of it which is actually what counsel for Pioneer argued to the District Court that it was in the quoted portion of a November 13th, I believe it was 1997 transcript, it is counsel for Pioneer who says that we should only interpret the "switching" element, that it is the "principal" element at issue here and that it would be dispositive. Unlike Mr. Brown's representation, there was certainly no deal with the Patent Office. The Patent Office rejected claim 6 based on indefiniteness and did not indicate, and I think this is very important to note, did not indicate that that claim, if rewritten in independent form, would have been allowable. And in fact there is section 707 of the M.P.E.P. which says the examiner should have said so if he thought so.

JUDGE: That's the implication isn't it? Getting away from the word "deal" which has an odious implication. When there's a rejection the implication is if you respond to the rejection the claim would be allowed even without the formality which the M.P.E.P. sort of recommends.

Ms. ELSON: Correct, Your Honor. So there was certainly no deal and it was the patentee's choice to go with adding additional limitations and we submit that was to ensure allowance of the claims in a more expeditious manner. They obviously intended to engage in a licensing program following issuance of the claim. Just looking more analytically at the approach that we should make here under *Warner-Jenkinson*, we've got to consider why was the amendment made. We submit that it was certainly not unrelated to patentability. Pioneer argues in its brief that the amendment was voluntary, which frankly directly contradicts the argument they made in the underlying District Court which was that the amendment was inadvertent, a mistake, and clear error, and I would cite A1077 where they quote Mr. Beecher, the prosecuting attorney, submits a declaration saying "unfortunately and not realized by me at the time I inadvertently added the word switching," yet now they claim it was done voluntarily. The patent attorney's declaration –

JUDGE: You mean voluntarily as opposed to required.

Ms. ELSON: Voluntarily, volition, intentionally, that it was somehow added for clarification, whatever you would argue that to be, it's certainly not inadvertent. So we submit that argument really can't be considered because it was first raised on appeal first of all, moreover

the prosecuting attorney under several cases, *Lear Siegler* and *Senmed*, is a formulation for litigation years after prosecution and should be immaterial to the claim construction and that's the only thing they really rely on for the voluntary arguments. Certainly it can't be unrelated to patentability. Moreover, the declaration is not part of the public record and this violates the public notice function of the patent. So now we look to see perhaps was it unclear, the second prong discussed in *Warner-Jenkinson*, and we submit that it's not unclear, but to the extent someone could argue that it is unclear, it certainly was the patentee's choice to make that amendment, and it's not clear because they didn't choose to pursue whether the claim would have been allowed without the amendment. Although, and the court has said, the Supreme Court, "as between the patentee who had a clear opportunity to negotiate broader claims but did not do so and the public at large, it is the patentee who must bear the cost of failure to seek protection for the foreseeable alteration of its claimed structure," citing *Sage*. If the court concludes that the reason is unclear and certainly the District Court had some questions, the District Court in its opinion said that "while the plaintiff provides a possible explanation for inconsistencies between the original and amended applications, it by no means dispels all questions concerning the prosecution history," this was at A23. So if we conclude that it's simply unclear then the presumption applies and the range of equivalence should be zero. Now if we consider what we submit, which is that it was clearly to overcome the Carpenter reference, we should consider the approach in *Sextant* really is the, the approach is laid out there to consider what is the

scope of estoppel. First we would submit that Pioneer did not dispute the first part of the District Court's opinion, which really discussed the all elements rule. The court concluded, made a finding that "switching" is the "precise converse of non-switching." Pioneer does not appeal that finding and the standard would be clear error but they simply didn't appeal it, and moreover they stipulated, they stipulated and did not try to argue there was some range of equivalence in front of the District Court. We never reached summary judgment, summary judgment was simply deemed granted and they stipulated to that. So the only question they raised on appeal is does prosecution history estoppel apply. That's why we're here.

JUDGE: "Switching" is a property of an element, it's not an element itself, is it? It's a limitation, it's a description, but other than that there couldn't ever be any equivalent of anything.

Ms. ELSON: I would disagree, Your Honor. We have the declaration of the expert Blauschild which the court relied on to look at the term "switching." The term "switching" itself is not, the switching analog multiplier that the disclosure refers to, and by the way the disclosure is a switching analog multiplier, does not define the term "switching" in and of itself. Although it does show a clock circuit which is characteristic of a switching analog multiplier. Mr. Blauschild, basically, in his declaration said that the switching and non-switching are two classes of analog multipliers and Pioneer – the court found that "switching" is the precise converse.

JUDGE: Isn't that the element, the multiplier is the element and some switch and some don't switch.

Ms. ELSON: Correct, there are two different classes of circuits that we can draw a dividing line down the middle because the court found, and this finding has not been appealed, that switching is the precise converse of non-switching. So going with that, going with Mr. Blauschild's declaration which puts them into two complete different classes, then we have Pioneer stipulating to the court's findings other than the application of prosecution history estoppel.

JUDGE: But they didn't stipulate that non-switching and switching are not equivalent. That's an issue in this case. They didn't stipulate that away.

Ms. ELSON: What they stipulated was that they would not appeal the court's ruling under the all elements rule which was the first part of the court's decision, finding that, to try and derive some kind of equivalence out of switching. To impede upon the non-switching category of devices would be to vitiate the claim element. They specifically added "switching," they told the patent examiner they were trying to set out the "precise details" of their circuitry, what they disclosed was the switching analog multiplier. I would cite, actually there has been some recent case law that is directly on point, which was not cited in the briefs because they are fairly new. One is *Moore v. Standard Register Company*, decided September 22nd. In this case there was a majority-minority discussion which is applicable. There was also the case of *CAE Screenplates v. Fiedler*. I apologize, I don't have the cites, there are just the slip opinions. That

this was decided August 24th, 2000 and this was also very similar as far as the bottom plate limitation. *Sextant* is also on point as well as *Kinzenbaw* which is at 741 F.2d 383 and *Tronzo v. Biomet*, 156 F.3d 1154. In all these cases there was a limitation such as hemispherical, for example. The "hemispherical" did modify something, but it was decided that the hemispherical limitation was a limitation and I see that I am out of time. But in those cases the distinction was drawn, basically Pioneer has stipulated to that. The only question is the scope of equivalence. So we look at how a reasonable competitor would have interpreted that file history, and we submit a reasonable competitor could only have interpreted it, as two did, to mean that "switching" means "switching," frankly. Thank you.

JUDGE: Mr. Brown.

MR. BROWN: Thank you. Let me first address a comment you, Judge Mayer, made during counsel's argument. I think you said "mistake doesn't matter." Let me, with all respect, challenge that, that statement Your Honor. I think mistake does matter. A mistake if we can show it, and I think we have, is a reason that is not related to patentability. I believe a mistake does matter, Your Honor. Secondly, it's argued that because the applicant said the specific combination is not in the prior art, that all of a sudden there's an estoppel across the board on every component.

JUDGE: Isn't the reissue statute precisely intended to deal with a mistake?

MR. BROWN: Yes.

JUDGE: And if there was really a mistake, your client had two years to deal with it.

MR. BROWN: You're right Your Honor, unfortunately as a practical matter, I hope Your Honor can appreciate –

JUDGE: But you're asking us to override the limitations of a statute, which has a means with dealing with mistake.

MR. BROWN: No. I'm asking you to frankly comply with the Supreme Court's repeated admonishment that a litigant is entitled to a range of equivalence and not to take that away from us. That's all I'm asking the Court. It was argued that, again, the specific combination is not in the art, but that was not a statement that each element was missing from the art, but simply a statement of novelty that every applicant's required to make. To be sure, we are not trying to read this claim on a combination of old elements. It's argued that "switching" was required. Not even the examiner agreed with that position. The record shows that he stood ready to issue claim 6 without "switching." It had the modulator which distinguished it, and Carpenter was missing the modulator. There was mention made of the scope of estoppel, maybe that's worthy to comment upon for a moment. The *Read* case. When you look at this record, what do you see? You see the word "switching," which clearly, we say had no significance, but if you are going to engage in a presumption, if you're going not to find this record, not to overrule that presumption, you have to at least concede it's of very minor significance. Where it was the word modulator, in claim 6, that the examiner, persuaded the examiner not to object to that claim on art. The *Read* case says, as

I'm sure you know, that where there's a number of arguments for patentability there's not an estoppel against each one. Because the Court said that that would mean that the further away the prior art is from an invention, the less protection it would get. That's the rule that should apply in this case if the Court is going to find an estoppel. But I would submit to the Court, and I say it again, this case is different from all the ones that have come before the Court before in this area. The cases that came before, there was a rejection but there was no clue from the Patent Office as to what to do to overcome the rejection, therefore every single thing the applicant did in response to that rejection was either clearly to overcome it or presume to overcome it because of the suspicion. This case is different, we have claim 6. It cannot be ignored when you look at defense counsel's brief, I think there's only one sentence in the entire brief, all 50 pages, that talks about claim 6, because claim 6 is what makes the difference in this case. You have claims 6, you have an examiner who has not rejected it on art. It has a limitation, it's not "switching." The applicant's remarks clearly indicate he is acquiescent to the examiner's objections. He's not challenging a single one. His goal is to incorporate the limitations together and to write it in independent format. That was the deal, and I think the deal matters. This Court said in *Sage Products* that the purpose of an estoppel is to prevent the applicant from retrading or reneging on a deal. When you look at this case, unlike the prior cases of this Court, in *Warner-Jenkinson*, the deal is clear. And it is also clear that "switching" is not part of that deal. The reason for estoppel doesn't exist here. And

I respectfully submit that that should be the ruling of this Court. Thank you.

JUDGE: Thank you, case is submitted.
